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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/785,310 | 02/20/2001 | Geoffrey Wen Tai Shuy | 0941-0223P-SP | 1991 |
| 2292 7590 10/09/2003 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | EXAMINER MCPHERSON, JOHN A | |
| | | | ART UNIT 1756 | PAPER NUMBER |

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,310

Applicant(s)

SHUY ET AL.

Examiner

John A. McPherson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9-16,18-21,23-27 and 29-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9-16,18-21,23-27 and 29-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the Amendment filed 8/7/03.
2. The Amendment filed 8/7/03 successfully overcomes the objection and rejections set forth in paragraphs 2-4 of the Office Action dated 5/7/03. Accordingly, the objection and rejections are withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-7, 9-16, 18-21, 23-26 and 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 822 543 (EP '543) for the reasons of record as set forth in paragraph 5 of the Office Action dated 5/7/03, and as further discussed below.

4. Claims 1, 4-7, 9-16, 18-21, 23-27 and 29-39 are rejected under 35 U.S.C. 102(b) as being anticipated by WO00/04536 (WO '536) for the reasons of record as set forth in paragraph 6 of the Office Action dated 5/7/03, and as further discussed below.

Response to Arguments

5. Applicant's arguments filed 8/7/03 have been fully considered but they are not persuasive. With respect to the rejection over EP '543, Applicant argues that this reference discloses a recording layer consisting of a semiconductor layer and a reflecting metallic layer that can produce semiconductor/metal contacts inducing crystalline effect during light exposure, wherein the amorphous semiconductor layer (the reacting layer, such as Si) will crystallize starting from the semiconductor/metal (such as Si/Al) interface which results in the modulation of the reflectivity of the recording layer, however the signal resulting from such a transformation is small and limited, thereby limiting the design's applicability. However, the Examiner notes that the optical recording media of EP '543 meet every limitation of the presently claimed invention. While it may be true, as Applicant states, that the embodiments disclosed in EP '543 are limited with respect to design applications as compared to Applicant's broader invention, the disclosed (but limited) embodiments of the prior art still anticipated the presently claimed invention.

With respect to the rejection over WO '536, Applicant argues in the present invention, owing to a different recording mechanism from WO '536, optical contrasts are not limited to reflectivity changes resulting from oxidation, so that materials including non-oxides are applicable for the transparent layer and reflecting layer. Applicant states that to further clarify the difference between the present invention and WO '536, a new independent claim 40 applying non-oxides in the transparent layer is added. However, while WO '536 does not teach the non-oxides of new claim 40, oxides are still within the

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scope of claims 1, 4-7, 9-16, 18-21, 23-27 and 29-39, therefore these claims are still anticipated by WO '536.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (703) 308-2302. The examiner can normally be reached on Monday through Friday, 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (703) 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



John A. McPherson
Primary Examiner
Art Unit 1756

JAM
10/6/03